

OCT 04 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Frank Dombroski et al.
For	:	METHOD AND SYSTEM FOR
	:	AUTOMATICALLY PLANNING
	:	AND CALENDARING
	:	TRAVEL ARRANGEMENTS
Serial No.:	:	09/836,141
Filed	:	April 16, 2001
Art Unit	:	3629
Examiner	:	Janice A. Mooneyham
Att. Docket	:	RBT 3001
Confirmation No.	:	5796

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Non-Final Office Action dated July 5, 2007 and further to the Notice of Appeal filed concurrently herewith. Claims 1-44 are pending in the present application of which claims 1, 2, 3, and 10 are independent. Claims 27-44 have been withdrawn from consideration. Applicant hereby requests review of the non-final rejections in the above-identified application, in view of the concurrently filed Notice of Appeal.

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REJECTION UNDER 35 U.S.C. § 112

In section 3 on page 3, the Office Action rejects claims 1-26 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed for at least the following reasons.

The Office Action alleges that "selecting business rules based on at least two ranked and prioritized categories" is new matter. In particular, the Office Action states that "by moving this limitation up to define the car and hotel booking process, this limitation is new matter."

Applicant respectfully disagrees with the assertions made in the Office Action. "The proscription against the introduction of new matter in a patent application serves to prevent an applicant from adding information that goes beyond the subject matter originally filed." See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 U.S.P.Q. 323, 326 (CCPA 1981). Thus, "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." See MPET § 2163.06. Ultimately, the "factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 U.S.P.Q. 2d at 1117.

Independent claims 1, 2, 3, and 10 relate to systems and methods for "automatically planning, booking and calendaring travel arrangements." These claims each recite selecting "business rules based on at least two ranked and prioritized categories." However, these claims do not *require* that this subject matter applies to the car and hotel booking process, as relied upon by the Office Action in the rejection. Rather, these claims can be read such that the step of

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"selecting business rules based on at least two ranked and prioritized categories" applies to the air booking process, as described in paragraph [0093] of the specification. Paragraphs [0176]-[0490] of the specification provide extensive details regarding the implementation of the process for generating business rules based on ranked and prioritized categories. Thus, given this extensive description, the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date, Applicant was "in possession of the invention as now claimed" in claims 1-26.

By characterizing "selecting business rules based on at least two ranked and prioritized categories" as requiring a car and hotel booking process including ranked and prioritized categories, the Office Action has failed to acknowledge that this subject matter includes ranked and prioritized categories in the air booking process, which is not new matter. Accordingly, Applicant respectfully submits that claims 1-26 satisfy the written description requirement. For at least the foregoing reasons, Applicant respectfully requests that the rejection of claims 1-26 under 35 U.S.C. § 112, first paragraph, be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

On pages 3-6, the Office Action rejects claims 1-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Publication No. 2002/0156661 to Jones et al. (hereinafter "Jones") in view of U.S. Publication No. 2002/0032589 to Shah (hereinafter "Shah"). On pages 6-9, the Office Action rejects claims 1-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones in view of "I-tinerary.com to Create First Travel Itinerary Site for Mobile Device Users" (hereinafter "I-tinerary"). On pages 9-13, the Office Action rejects claims 1-26 under 35 U.S.C.

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§ 103(a) as allegedly being unpatentable over Jones in view of "Galileo International Announces Corporate Travelpoint 2.0" (hereinafter "Travelpoint"). Applicant respectfully traverses these rejections.

Independent claims 1, 2, 3, and 10 recite selecting "business rules based on at least two ranked and prioritized categories related to travel preferences."

Jones does not disclose, teach, or suggest the above quoted subject matter. The system of Jones executes a series of steps in which it finds the closest airport, searches the travel database for flights, and presents those alternatives to the user based on inputted parameters including a destination, location, and the user's origination site. See paragraphs [0041]-[0044]. Thus, the travel system of Jones simply executes a predetermined, inflexible process utilizing the entered parameters and does not select business rules, as recited in claims 1, 2, 3, and 10. Moreover, the constraints in the constraint relaxation system described in paragraphs [0057-0058] are all of equal importance and are not prioritized. If a user specified that he or she was "completely flexible" for both the alternative departure city and alternative arrival city, the constraint relaxation system would give both constraints equal weight. Accordingly, Jones does not disclose, teach, or suggest selecting "business rules based on at least two ranked and prioritized categories," as recited in claims 1, 2, 3, and 10. Shah, I-tinerary, and Travelpoint fail to make up for the deficiencies in Jones and, thus, are correctly not relied upon in the rejection with respect to that subject matter.

Apparently perceiving these deficiencies in the prior art of record, the Office Action takes "Official Notice that it is old and well known to apply business rules which take into account ranking and prioritization preferences in the reservation industry." In so doing, the Office Action

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attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the applicable subject matter.

Applicant respectfully submits that the Official Notice is improperly taken. According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner takes Official Notice, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit.

Furthermore, an Examiner may not rely on official or judicial notice at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *See Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). Here, the Examiner has taken Official Notice regarding selection of "business rules based on at least two ranked and prioritized categories related to travel preferences," which the prior art of record fails to show. In the Amendment filed May 21, 2007, Applicant argued novelty over Jones based on this subject matter recited in the rejected claims. Accordingly, Applicant requests that the Examiner come forward with prior art showing the various deficiencies in the applied prior art references and demonstrate the motivation to combine the various teachings of such references with that of the applied references.

For at least the forgoing reasons, Applicant respectfully submits that the Office Action has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests that the rejections of claims 1-26 under 35 U.S.C. § 103 be withdrawn.

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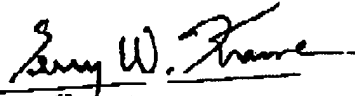
CONCLUSION

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant pre-appeal brief request for review places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner contact the correspondence attorney listed below at the telephone number listed below in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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Date: October 4, 2007

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